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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,328	02/05/2004	Hiromi Tabuchi	1131-0500P	4066

2292 7590 10/24/2006

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EXAMINER	
EDEL, JOHN B	
ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/771,328	TABUCHI ET AL.	
	Examiner	Art Unit	
	John B. Edel	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

(1)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5,494,055 to Noe et al ("Noe").

Regarding Claim 1: Noe discloses a rod like filler and the wrapper wrapped around that filler,[1] an outer wrapper surrounding an inner wrapper (col. 4 lines 40-41), and a perfume emitting layer (col. 3 lines 15-19 and 55-61) between the inner and outer layer (col. 7 lines 40-50).

Regarding Claim 2: Noe discloses applying the additive to both layers of the double wrapper cigarette (col. 3 lines 31-35; col. 3 line 55 – col. 4 line 10).

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[1] The invention of Noe is applied to cigarettes (col. 1 line 8) and Noe describes the invention as covering the smokeable tobacco goods (col. 2 14-15). Together these teachings show that the inner wrapper would be wrapped around the tobacco filler rod.

Claim Rejections - 35 USC § 103

(2)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(3)

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe in view of WIPO publication WO/2001/15555-A1[2] to Hideki Nagae et al ("Nagae").

Regarding Claims 3 and 4: Noe discloses those features previously enumerated in the treatment of Claim 2. Noe fails to expressly disclose that the additive may be included in the glue or that that glue is polyvinyl acetate glue. Nagae discloses that additives may be added into the glue of a double wrapper cigarette (see footnote regarding WO/2001/15555-A1) and the use of polyvinyl acetate based adhesives as that glue (see footnote regarding WO/2001/15555-A1). Noe and Nagae are analogous because they both come from the art of reducing side stream smoke in cigarettes. It would be obvious to use the glue of Nagae in the cigarette of Noe because doing so would incorporate the perfume into the cigarette by using glue application techniques that are well known in cigarette manufacturing.

Regarding Claim 5: Noe discloses using encapsulated additive (col. 3 lines 55-67) which may be classified as either a grain form or as a powder form. Therefore it would have been obvious to combine Noe with Nagae to obtain the invention as specified in claims 3-5.

(4)

Claims 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe in view of United States Patent No. 2,999,520 to W. B. Lowman et al. ("Lowman").

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[2] WIPO publication WO/2001/15555-A1 published August 23, 2000 is in Japanese. All references to this document are made with the presumption that the WIPO document contains similar disclosures as the Canadian National Stage Publication (CA-2381634) of the same PCT application. The relevant disclosures from the Canadian National Stage document are located at page 5 line 12 to page 6 line 4 of the disclosure.

Regarding Claim 6: Noe discloses a manufacturing machine for manufacturing a double wrapper cigarette, comprising: a first feeding path along which an inner web is fed, a second feeding path along which an outer web is fed, a wrapping section for continuously forming a tobacco rod by receiving the inner and outer webs from said first and second feeding paths, laying the inner web on the outer web to thereby form a double web, receiving a filler including a tobacco material on the double web, and wrapping the double web around the filler (col. 4 lines 20-33)[3] and at least one perfume material supply device located along one of said first and second feeding paths, said perfume material supply device being so provided as to apply material including a perfume onto at least one of the inner and outer webs fed along said first and second feeding paths in the form of a layer, to thereby form a perfume emitting layer between the inner and outer webs of the double web (col. 4 lines 55-59; claim 1). Noe fails to disclose a cutting section for cutting the tobacco rod formed at said wrapping section into pieces of a predetermined length. Lowman discloses a cutting section for cutting the tobacco rod formed at said wrapping section into pieces of a predetermined length (col. 2 lines 4-7). Noe and Lowman are analogous art because both come from the art of manufacturing cigarettes. It would be obvious to one having ordinary skill in the art at the time of the invention to further process the tobacco rod of Noe by cutting the tobacco rod with a device as disclosed in Lowman because Lowman discloses such cutting as following the formation of a tobacco rod (col. 2 lines 4-7).

[3] The inner and outer web would necessarily have a feeding path along which the webs travel before being joined prior to the cigarette-making machine.

Regarding Claim 7: Noe discloses the use of a nozzle type applicator for the application of the perfume material (col. 4 lines 40-46). One having ordinary skill in the art of cigarette manufacturing would recognize nozzles as being among the most common "devices ... available on the market" for spraying.

Regarding Claim 8: Noe discloses the use of a glue applicator for applying glue to one of the webs (col. 4 lines 34-39), the application of the perfume emitting substance as a powder or grain (encapsulated form) (col. 3 line 55 to col. 4 line 2) with a diffuser (see treatment of claim 7, nozzles being a type of diffusing devices).

Regarding Claim 10: Noe discloses a method of manufacturing a double wrapper cigarette, comprising the steps of: feeding an inner web and an outer web to a wrapping section of a cigarette manufacturing machine, and, at an inlet of the wrapping section, laying the inner web on the outer web to thereby form a double web (col. 4 lines 20-33), applying material including a perfume material onto at least one of the inner and outer webs in the form of a layer while the inner and outer webs are being feed to thereby form a perfume emitting layer between the inner and outer webs of the double web (col. 4 lines 55-60; claim 1), supplying a filler including a tobacco material onto the double web at the inlet of the wrapping section, forming a tobacco rod continuously by wrapping the double web around the filler while the double web is passing through the wrapping section together with the filler (col. 4 lines 20-33). Noe does not disclose what Lowman discloses, cutting the tobacco rod into pieces (Lowman col. 3 lines 4-7). It would be obvious to one having ordinary skill in the art at the time of the invention to further process the tobacco rod of Noe by cutting the tobacco rod with a device as

disclosed in Lowman because Lowman discloses such cutting as following the formation of a tobacco rod. It would therefore be obvious to a person having ordinary skill in the art to combine Noe with Lowman to obtain the invention as specified in claims 6-8 and 10.

(5)

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noe in view of Lowman as applied to claim 8 above, and further in view of United States Patent No. 2,320,702 to J. Marchese et al. ("Marchese") and United States Pre Grant Publication No. US 20010009938 A1 to Eckstein et al. ("Eckstein"). Noe does not disclose that the perfume is added with a brush or that a second brush is used to remove the surplus of the perfume. Eckstein discloses that coating a paper with a brush is customary in the paper industry (paragraph 0110). Eckstein is analogous art because both Eckstein and Noe relate to the coating of paper with additives. It would be obvious to use the brush of Eckstein to coat the paper of Noe because Eckstein discloses that a brush is a common substitute for other coating apparatuses. Marchese discloses that removing surplus additive may be accomplished with a brush (page 2 col. 2 lines 48-52). Marchese and Doe are analogous art because they both relate to the art of coating paper. It would be obvious to one having ordinary skill in the art at the time of the invention to add the brush of Marchese to remove excess additive from the paper because doing so would result in a more uniform coating of the paper.
Therefore, it would have been obvious to combine Noe, Nagae, and Lowman with Marchese and Eckstein to obtain the invention as specified in claim 9.

Conclusion

(6)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Edel whose telephone number is (571) 272-4804. The examiner can normally be reached on 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBE

ERIC HUG
PRIMARY EXAMINER